IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Confirmation No.: 7148
Cheng-Liang HOU	Art Unit: 2616
Application No.: 10/748,223	Examiner: Juntima, Nittaya
Filed: December 31, 2003	Atty. Docket: 2875.2880000
For: **System and Method for Controlling Packet Transmission Using a Plurality of Buckets**	

Reply Brief Under 37 C.F.R. § 41.41

Mail Stop Appeal Brief - Patents

Commissioner for Patents
PO Box 1450
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Sir:

Appellant filed a Brief on Appeal to the Board of Patent Appeals and Interferences for the above-captioned application on October 20, 2008. The appeal is directed to the final rejection of claims 1-19 under 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a), as set forth in the Final Office Action mailed April 29, 2008. The Examiner's Answer was mailed January 22, 2009. In reply to the Examiner's Answer, Appellant respectfully submits this Reply Brief under 37 C.F.R. § 41.41.

It is not believed that payment of fees is required beyond that which may otherwise be provided for in documents accompanying this paper. However, if payment of a fee is necessary to prevent abandonment of this application, then such payment therefore is hereby authorized to be charged to our Deposit Account No. 19-0036.

I. Argument

This Reply Brief addresses the points raised by the Examiner in the '(9) Grounds of Rejection' section of the Examiner's Answer. For ease of analysis, the main point headings of this Reply Brief correspond to the point headings used in Appellant's Brief on Appeal and the Examiner's Answer. For additional structure, subheadings are added where helpful to highlight individual arguments. Additionally, in the arguments below, references are also made to the '(10) Response to Argument' section of the Examiner's Answer.

(9)A. Appellant Maintains That the Rejection of claims 1-6, 9-16, and 19 under 35 U.S.C. § 102(e) over Buskirk is in Error and Must be Reversed.

Claims 1-6, 9-16 and 19 were rejected under 35 U.S.C. § 102(e) as being anticipated by Buskirk (U.S. Patent Publication No. 2006/0159019). In the Examiner's Answer, the Examiner restates the basis for the prior rejection of claims 1-6, 9-16 and 19. The Examiner's position is clearly erroneous, and the rejection of claims 1-6, 9-16 and 19 must be reversed. Appellant maintains its position that Buskirk does not teach or suggest all the features of Appellant's claims 1-6, 9-16 and 19.

Appellant respectfully submits the following further arguments in response to positions taken by the Examiner in the Examiner's Answer. As discussed in the Appellant's Brief on Appeal, independent claims 1, 10 and 11 recite features that distinguish over Buskirk. For example, as recited in claim 1, and by respective language in claims 10 and 11, "[1] setting a plurality of packet type filters", "[2] so that each of said packet type filters performs filtering for a different packet type;" and "[3] incrementing a plurality of buckets, each bucket communicatively coupled to a packet type filter of the plurality of filters[.]"

The Examiner's Answer merges the arguments with respect to these elements, and because these inquiries are significantly different, the inquiries will be addressed separately below.

1. ***The element "setting a plurality of packet type filters" is not disclosed expressly or inherently in Buskirk.***

Buskirk does not expressly or inherently disclose "setting a plurality of packet type filters" as recited in claim 1 and by respective language in claims 10 and 11. Accordingly, Applicants respectfully request that this rejection to claims 1, 10 and 11 be reversed.

a. The Examiner has improperly relied upon inherent disclosure.

Because Buskirk lacks an express disclosure of "setting a plurality of packet type filters," in the Examiner's Answer at page 13, the Examiner has relied, we believe improperly, upon alleged inherent disclosure in Buskirk to anticipate claim features under 35.U.S.C. § 102(e):

> Since more than one packet type is present and classified, the classifier 402 **must have a number of different means/elements,** which correspond to the claimed "plurality of packet type filters", that classify different packet types because each of the means/elements, whether it is hardware or software, **must be dedicated** to classifying a packet into one of the packet types.

By stating that the classifier "must have a number of different means/elements," the Examiner is stating a reliance upon an alleged inherent teaching of Buskirk. The Examiner's reliance on the principles of inherency in the rejection of claim 1 and by respective language, claims 10 and 11, is clearly erroneous because it is not reasonably supported.

As summarized by Patent Law Fundamentals, Second Edition: "To rely on the doctrine of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic **necessarily flows** from the teachings of the applied prior art. *In re King,* 801 F.2d 1324, 1327 (Fed. Cir.

1986); . . . *Ex Parte Levy,* 1990 WL 354577 (Bd. Pat. App. & Interferences 1990)." 1 Pat. L. Fundamentals § 8:5 (2d ed.) (Doctrine of Inherency).

As stated in the Examiner's Response to Argument on page 13 of the Examiner's Answer, the Examiner's whole argument for anticipation of this element is that, merely because "more than one packet type is present and classified, the classifier 402 **must have** a number of different means/elements, which correspond to the claimed "plurality of packet type filters." Such a conclusion ignores the potential that the single classifier in Buskirk, without the alleged plurality of means/elements, could also perform the classification of more than one packet type. Thus in terms of an inherency analysis, a "plurality of packet filters" does not necessarily flow from the disclosure of a single classifier.

This Board is referred to M.P.E.P. Section 2112(IV), which states, in relevant part, "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic" (citation omitted). The Examiner's position is clearly erroneous at least because the Examiner has provided no extrinsic evidence or additional argument as to why the classifier could not perform its disclosed classifying function without the alleged plurality.

b. A classifier is not a filter.

In addition to the arguments above, the Board is reminded that there is no equivalency in the art between a classifier and a filter such that the functions of one are necessarily present in the other. In Buskirk, paragraph [0062] defines the classifier as the following:

> As previously indicated, an upstream classifier module **classifies the incoming stream into separate logical flows, and assigns a flow identifier.**

> **A flow identifier can be stored as a flag, or may include some other appropriate identification process,** such as in accordance with an exemplary embodiment where the flow identifier is embedded into a local header. In such an embodiment, a packet is classified as belonging to the flow if this identifier appears in the start of a frame word, and there should only be one entry for each supported flow. The flow can then be identified **620** by reading the embedded flow identifier in the local header. Packets with unrecognized identifiers will be marked appropriately, such as by marking as "red."

This simple classifier in Buskirk "determine[s flows] by monitoring any particular field of a packet header." Id. at paragraph [0058].

In contrast, as recited in claim 1, and claims 10 and 11 by respective language, a 'packet type filter' is generally able to use a broad range of criteria when filtering packets based on packet type. *Cheeha Kim, Information Networking* (Springer, 2005) ("In practice, the packet filter often uses a large number of rules[.]").

The Examiner has provided no additional extrinsic evidence or argument as to why the functions of a packet filter necessarily flows from the operation of a classifier, and thus the Examiner's reasoning is clearly erroneous.

c. Buskirk teaches away from the use of a plurality of packet type filters.

The Examiner, on page 13 of the Examiner's Answer, in support of the inherency argument discussed above, suggests that the 'separate logical flows' of Buskirk signify that the reference 'must have' a plurality of packet type filters:

> It is respectfully submitted that the classifier 402 of Buskirk reads on a plurality of packet type filters and that Buskirk teaches setting or configuring a plurality of packet type [sic] so that each of the packet type filters performs filtering for a different packet type. **In particular, Buskirk teaches that the classifier 402 in Fig. 4 classifies/parses the incoming stream into separate logical flows** (paragraph 0055) and that each flow is based on the packet type (paragraph 0058).

The Examiner misunderstands the significance of the classification/parsing of "the incoming stream into separate **logical** flows[.]" This reference to "logical flows" actually refers to the multiplexing of multiple separate packet flows into a "**single stream**," as disclosed in Buskirk at paragraph [0030]:

> The policing method and apparatus may be used with multiple packet flows and multiple packet protocols, **where the multiple packet flows are multiplexed into a single data stream** . . . . The invention provides policing on multiple flows and protocols by determining which flow and protocol each packet is associated with, and carrying out an appropriate operation depending on the type of flow to which the packet belongs. **This allows the policing module to be used generically in a system, such as a router,** switch, bridge, etc., even where multiple network protocols are used.

Far from supporting the Examiner's argument, the multiplexed "logical flows" of Buskirk actually teach away from the need for "a plurality of packet type filters." By stating that the single multiplexed stream "**allows the policing module** to be used generically in a system[,]" Buskirk is suggesting that this merging of flows is a factor that enables a Buskirk single policing module to be used. This position is emphasized in Buskirk's "Background of Invention," where the reference suggests that the Buskirk integrated approach will satisfy a need to integrate the handling different types of packets:

> Currently, **varying data protocols require different methods** for policing traffic flows . . . . Accordingly, there is a need in the communications industry for a method and apparatus **for commonly policing packets of multiple transmission protocols**."

While the Examiner has selected individual, unconnected aspects to highlight in the Buskirk reference, the totality of the Buskirk disclosure teaches away from a finding by this Board of an inherent disclosure of this claimed feature.

2. ***The element "so that each of said packet type filters performs filtering for a different packet type" is not disclosed expressly or inherently in Buskirk.***

Appellant maintains the argument that, assuming, *arguendo*, that the Buskirk reference expressly or inherently discloses "setting a plurality of packet type filters," a position to which the Appellant does not acquiesce, the resultant alleged plurality is not necessarily set "so that each of said packet type filters performs filtering for a different packet type[.]"

This Board is reminded that the Examiner, by merging the arguments as to the inherent disclosure of a "plurality of packet type filters," and the inherent disclosure of the feature that "each of said packet type filters performs filtering for a different packet type," has failed to specifically address this second claimed element. The Examiner would have this Board apply an inherency analysis first, to show that Buskirk discloses a plurality of packet type filters, then again use inherency analysis to show this second above-described claimed element.

Appellant respectfully submits that, clearly lacking an express disclosure of a claimed feature, the Examiner has improperly relied upon alleged inherent disclosure in Buskirk to anticipate features under 35.U.S.C. § 102(e). On page 13 of the Examiner's Answer, the Examiner states:

> Since more than one packet type is present and classified, the classifier 402 must have a number of different means/elements, which correspond to the claimed "plurality of packet type filters", **that classify different packet types because each of the means/elements, whether it is hardware or software, must be dedicated to classifying a packet into one of the packet types**.

By stating that each of the alleged plurality of packet filter elements in the Buskirk classifier "**must be dedicated** to classifying a packet into one of the packet types" the Examiner is stating a reliance upon an alleged inherent teaching of Buskirk. The Examiner's reliance on

the principles of inherency in the rejection of claim 1 and by respective language, claims 10 and 11, is not reasonably supported and is thus clearly erroneous.

Similar to the discussion above, there is no mandate that each of the allegedly disclosed plurality of packet type filters is necessarily performing the above described element. In fact, the Buskirk "common" approach applied to a "single stream," discussed above, suggests that Examiner's alleged plurality of packet type filters could also commonly share the packet types for which they filter. Paragraph [0014] of Buskirk reinforces this argument:

> "[0014] A policing processor is coupled to the classifier to receive each of the traffic flows. The processor is configured to convert each of the packets into a predetermined format, and to perform a shared bandwidth capacity test in order to determine packet conformance for each of the packets. **The shared test is applied to all packets, regardless with their original protocol affiliation**."

As argued above, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic." M.P.E.P. Section 2112(IV). The Examiner's position is clearly erroneous because the Examiner has provided no extrinsic evidence or additional argument as to why the alleged plurality of packet type filters are necessarily set "so that so that each of said packet type filters performs filtering for a different packet type" as recited in claim 1 and by respective language, claims 10 and 11.

3. ***The element "incrementing a plurality of buckets, each bucket communicatively coupled to a packet type filter of the plurality of filters" is not disclosed expressly or inherently in Buskirk.***

Assuming, *arguendo*, that the Buskirk reference expressly or inherently discloses "setting a plurality of packet type filters so that each of said packet type filters performs

filtering for a different packet type," a position to which the Appellant does not acquiesce, the resultant method does not necessarily further have "incrementing a plurality of buckets, each bucket communicatively coupled to a packet type filter of the plurality of filters[.]"

On page 4 of the Examiner's Answer, the Examiner states:

> Incrementing a plurality of buckets, each bucket communicatively coupled to a packet type filter of the plurality of filters **(policing engine 700 in Fig. 7** having leaky buckets for corresponding flows, paragraphs 0070-0075).

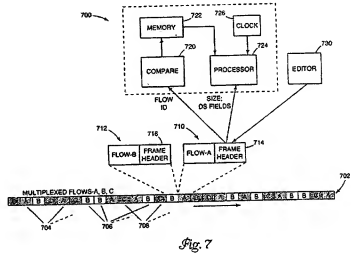

Fig. 7

The above paragraph shows that the Examiner has now, for this third feature, switched from the classifier 402 as inherently disclosing the "plurality of packet type filters," as discussed above, to the "policing engine 700" as expressly disclosing this claimed feature.

As argued above, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic." M.P.E.P. Section 2112(IV). Shown above, and cited by the Examiner, FIG. 7 shows a single policing engine 700 examining each and

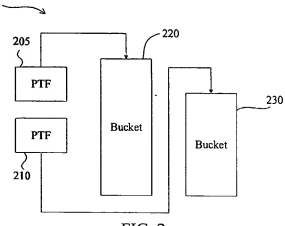

FIG. 2

every packet header in a single logical stream. The Examiner merely states an equivalence between the process depicted in this figure and the process depicted below by FIG. 2 of the instant application. FIG. 7 above does not show "incrementing a plurality of buckets, each bucket communicatively coupled to a packet type filter of the plurality of filters" and the Examiner's position is clearly erroneous because the Examiner has provided no extrinsic evidence or additional argument as to why the Buskirk single policing engine 700 anticipates the claimed features.

(9)B. Appellant Maintains That the Rejection of claims 7, 8, 17 and 18 under 35 U.S.C. § 103(a) over Buskirk in view of "Official Notice" is in Error and Must be Reversed.

Claims 7, 8, 17 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Buskirk and 'official notice.' The Examiner's position is clearly erroneous, and the rejection of claims 7, 8, 17 and 18 must be reversed. Appellant maintains its position, as set out on page 23 of Appellant's Brief on Appeal, that the combination of Buskirk and 'official notice' does not teach or suggest all the features of Appellant's claims 7, 8, 17 and 18. Appellant respectfully submits the following further arguments in response to the Examiner's Answer and in support of Appellant's arguments in the Brief on Appeal.

Dependent claims 7 and 8 necessarily include all of the features of claim 1, and dependent claims 17 and 18 necessarily include all the features of claim 11. As discussed above for a similar distinguishing feature, using respective language, as recited in claims 1 and 11, Buskirk does not teach or suggest at least the above noted distinguishing feature of claims 1 and 11, and thus cannot be used to render the features of dependant claims 7, 8, 17 and 18 obvious under 35 U.S.C. § 103(a).

In addition, the Examiner argues, which Applicant does not acquiesce to, that 'official notice' teaches or suggests certain elements of the pending claims. Applicants respectfully assert that the Examiner has inappropriately taken "official notice" of certain elements of the pending claims because, according to the M.P.E.P. at Section 2144.03(A) (emphasis added):

> Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, **these circumstances should be rare when an application is under final rejection** or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.

In this same Section, the M.P.E.P. then provides some examples of when "official notice" was deemed appropriate:

> In *Ahlert*, the court held that the Board properly took judicial notice that "it is old to adjust intensity of a flame in accordance with the heat requirement." See also *In re Fox*, 471 F.2d 1405, 1407, 176 USPQ 340, 341 (CCPA 1973) (the court took "judicial notice of the fact that tape recorders commonly erase tape automatically when new 'audio information' is recorded on a tape which already has a recording on it"). In appropriate circumstances, it might not be unreasonable to take official notice of the fact that it is desirable to make something faster, cheaper, better, or stronger without the specific support of documentary evidence.

The Examiner's assertions regarding certain elements of the pending claims do not fit within one of the narrow exceptions noted by this Section of the M.P.E.P. This Section of the M.P.E.P. also states "[i]t is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. [*In re Zurko*, 258 F.3d 1379, 1385 (Fed. Cir. 2001)]." Appellant therefore asserts that it is clearly erroneous for the Examiner to take "official notice" of this

concept without providing documentary evidence or pointing to documentary evidence on the record.

Accordingly, for at least this additional reason, the Examiner's rejection of claims 7, 8, 17 and 18 under 35 U.S.C. § 103(a) over Buskirk in view of 'official notice' is clearly erroneous and must be reversed.

(9)C. Appellant Maintains That the Rejection of claims 1-3, 6-13, and 16-19 under 35 U.S.C. § 103(a) over Weberhofer in View of the Specification is in Error and Must be Reversed.

Claims 1-3, 6-13 and 16-19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weberhofer (U.S. Patent No. 6,014,384) in view of paragraph [0003] of Appellant's disclosure, hereinafter 'A.D. [0003].' In the Examiner's Answer, the Examiner restates the basis for the prior rejection of claims 1-3, 6-13, and 16-19. The Examiner's position is clearly erroneous, and the rejection of claims 1-3, 6-13, and 16-19 must be reversed. Appellant maintains their position that the combination of Weberhofer and A.D. [0003] does not teach or suggest all the features of Appellant's claims 1-3, 6-13 and 16-19. Appellant respectfully submits the following further arguments in response to the Examiner's Answer and in support of Appellant's arguments in the Brief on Appeal.

As discussed above in section (9)A, and in the Appellant's Brief on Appeal, independent claims 1, 10 and 11 recite features that distinguish over Weberhofer alone, and in the allegedly obvious combination with A.D. [0003]. For example, "[1] setting a plurality of packet type filters," "[2] so that each of said packet type filters performs filtering for a different packet type;" and "[3] incrementing a plurality of buckets, each bucket

communicatively coupled to a packet type filter of the plurality of filters[.]" As with the discussion of Buskirk above, the Examiner has merged the arguments with respect to these elements, and because these inquiries are significantly different, the inquiries will be addressed separately below.

1. ***The element "setting a plurality of packet type filters" is not disclosed expressly or inherently in Weberhofer in View of the Specification.***

   a. ***The Examiner has improperly relied upon an inherent disclosure in Weberhofer.***

Neither Weberhofer, nor A.D. [0003], whether taken alone or in allegedly obvious combination, expressly or inherently disclose "setting a plurality of packet type filters" as recited in claim 1 and by respective language in claims 10 and 11. Accordingly, Applicants respectfully request that this rejection to claims 1, 10 and 11 be reconsidered and withdrawn.

Appellant respectfully submits that, again clearly lacking an explicit disclosure of "setting a plurality of packet type filters," the Examiner has improperly relied upon an alleged inherent disclosure to render features obvious under 35.U.S.C. § 103(a). On page 7 of the Examiner's Answer, the Examiner refers to Weberhofer:

> A plurality of buckets (a number of leaky-bucket systems, each bucket per QoS class), each communicatively coupled to the packet receiving engine (a number of leaky-bucket systems are connected to a data input point 16 via an access port), each communicatively coupled to a packet type filter of plurality of packet type filters (a mapper 18 and queues 19.1-19.4, **collectively, constitute a plurality of packet type filters because cells with different QoS are classified into corresponding queues, which means the mapper 18 must have a plurality of different means/elements for classifying** the received cells, and that each means/element, whether it is hardware or software, is dedicated to identifying a corresponding one of the QoS classes and assign it to an ATM cell), each packet type filter is set to filter at least one packet type.

As with the classifier in Buskirk described above, by stating that the mapper "must have a plurality of different means/elements for classifying," the Examiner is stating a reliance upon an alleged inherent teaching of Weberhofer. The Examiner's reliance on the principles of inherency in the rejection of claim 1 and by respective language, claims 10 and 11, is not reasonably supported. In addition, the Examiner's reliance upon inherency is not applicable to support this type obviousness rejection.

Once again, the Examiner's whole argument is that merely "because cells with different QoS are classified into corresponding queues [this] means **the mapper 18 must have** a plurality of different means/elements for classifying the received cells[.]" Such a conclusion ignores the potential that a single mapper in Weberhofer, without a number of means/elements, could also perform the classification of more than one packet type. As with the classifier of Buskirk, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic." M.P.E.P. Section 2112(IV).

The Examiner's position is clearly erroneous at least because the Examiner has provided no extrinsic evidence or additional argument as to why the mapper could not perform its disclosed classifying function without the alleged plurality.

b. The Examiner's Response to the Appellant's Inherency Argument

In response to Applicants' arguments regarding the inappropriate use of inherency to anticipate elements of claims 1, 10 and 11, the Examiner introduces the following test:

> In addition, MPEP 2112 supports rejection of claims under 35 U.S.C. 102 based on inherency and **the classification operation of Weberhofer, i.e., classifying a cell based on the packet type, is consistent with the "filter" operation** as disclosed in line 9 of paragraph 0020 of the specification as "a

> packet has been filtered, e.g., determined to be of a certain type." **Therefore**, it is respectfully submitted that the limitations of "a plurality of type filters" and "setting a plurality of type filters so that each of said packet type filters performs filtering for a different packet type" is fully met.

In contrast to the permissive "*is consistent with*" test for inherency, as suggested by the Examiner, the M.P.E.P and the Federal Circuit actually require that "[t]o rely on the doctrine of inherency, the Examiner **must** provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic **necessarily flows** from the teachings of the applied prior art. *In re King,* 801 F.2d 1324, 1327 (Fed. Cir. 1986).

This Board is reminded that each and every assertion made by the Examiner with respect to inherency discussed herein is presumably informed by the erroneous standard set forth above.

c. A mapper is not a filter.

In addition to the arguments above, this Board is reminded that there is no equivalency in the art between a mapper and a filter such that the functions of one are necessarily present in the other. Weberhofer, wholly defines its mapper at Col. 4, lines 47-50:

> This mapper determines which QoS class a cell belongs to, and directs it to the proper queue 19.1 through 19.4. ATM cells of higher transmission priority are thus separated from those of lower transmission priority. The length of the queues 19.1 through 19.4 is coordinated to the maximum (or average) burst size of the corresponding transmission service.

Mappers in the art are generally associated with marking, i.e., mapping, incoming data packets according to a packet header. *See, e.g., Dr. Yi-Bing Lin & Ai-Chun Pang, Wireless and Mobile All-IP Networks* ("[The] [p]acket mapper . . . marks each incoming data packet

with a specific QoS indication related to the bearer service, and translates the QoS parameters of the outgoing data packet into those of the external PDN."). In the art, mapping by a mapper is generally accomplished by simply reading information about a packet that has been stored in a packet header.

In contrast, as discussed above with respect to the Buskirk classifier, a 'packet type filter' is generally able to use a broad range of criteria when filtering packets based on packet type. Under an inherency analysis, the Weberhofer mapper, with its simple mapping functions, cannot be used to anticipate the claimed "plurality of packet type filters" without the Examiner providing "a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic **necessarily flows** from the teachings of the applied prior art." *In re King,* 801 F.2d at 1327.

The Examiner's position is clearly erroneous at least because the Examiner has provided no additional extrinsic evidence or argument as to why the functions of a packet filter necessarily flows from the operation of a classifier, and thus the Examiner's reasoning is clearly erroneous.

2. ***The elements "so that each of said packet type filters performs filtering for a different packet type" and ""incrementing a plurality of buckets, each bucket communicatively coupled to a packet type filter of the plurality of filters"are not disclosed expressly or inherently in Weberhofer in view of the Specification.***

Assuming, *arguendo*, that the Weberhofer expressly or inherently discloses "setting a plurality of packet type filters," a position to which the Appellant does not acquiesce, the resultant plurality is not set "so that each of said packet type filters performs filtering for a different packet type[.]"

Once again, by merging the arguments as to the inherent disclosure of a "plurality of packet type filters," and the inherent disclosure of the feature that "each of said packet type filters performs filtering for a different packet type," the Examiner has failed to specifically address this second claimed feature. As with the anticipation by Buskirk, the Examiner would have this Board apply an inherency analysis, first to show the plurality of packet type filters exists, then again use inherency analysis to show this additional above-described feature[.]"

In the Examiner's Answer at page 8, the Examiner initially admits that "Weberhofer fails to explicitly teach a packet handling engine, communicatively coupled to the packet receiving engine." The Examiner then argues that A.D. [0003] teaches these certain elements of the pending claims. Applicant does not acquiesce to the Examiner characterization of A.D. [0003] that it teaches or suggests these claim elements.

It is long standing law that inherency is not applicable in an obviousness analysis such as here, when the inherent feature of the claimed invention is the result of the combination or modification of the prior art: "the inherency of an advantage and its

obviousness are entirely different questions. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown." *In re Spormann*, 363 F.2d 444, 448 (C.C.P.A. 1966) *citing In re Adams*, 356 F.2d 998 (C.C.P.A. 1966). A "retrospective view of inherency is not a substitute for some teaching or suggestion which supports the selection and use of the various elements in the particular claimed combination." *In re Newell*, 891 F.2d 899, 901 (Fed. Cir. 1989) *citing Smithkline Diagnostics v. Helena Laboratories Corp.,* 859 F.2d 878, 886-87 (Fed. Cir. 1988). Thus, Weberhofer in view of A.D. [0003] cannot inherently anticipate the above described features of claims 1 and by respective language claims 10 and 11.

Assuming, *arguendo* that the Examiner may properly utilize inherency for this obviousness analysis, as with Buskirk above, there is no mandate that each of the allegedly disclosed "plurality of packet filters" is **necessarily** set "so that each of said packet type filters performs filtering for a different packet type[.] As argued above, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic." M.P.E.P. Section 2112(IV).

The Examiner's position is clearly erroneous because the Examiner has provided no extrinsic evidence or additional argument as to why the alleged plurality of packet type filters are set "so that so that each of said packet type filters performs filtering for a different packet type" as recited in claim 1 and by respective language, claims 10 and 11.

(9)D. Appellant Maintains That the Rejection of claims 4-5 and 14-15 under 35 U.S.C. § 103(a) over Weberhofer in View of the Specification and further in View of Zhang is in Error and Must be Reversed.

Claims 4-5 and 14-15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weberhofer in view of A.D. [0003], and in further view of Zhang (U.S. Patent No. 7,130,917). In the Examiner's Answer, the Examiner restates the basis for the prior rejection of claims 4-5 and 14-15. The Examiner's position is clearly erroneous, and the rejection of claims 4-5 and 14-15 must be reversed. Appellant maintains their position, as stated on page 34 of Appellant's Brief on Appeal, that the combination of Weberhofer, A.D. [0003] and Zhang does not teach or suggest all the features of Appellant's claims 4-5 and 14-15. Appellant respectfully submits the following further arguments in response to the Examiner's Answer and in support of Appellant's arguments in the Brief on Appeal.

Dependent claims 4 and 5 necessarily include all of the features of claim 1, and dependent claims 14 and 15 necessarily include all the features of claim 11. As discussed above neither Weberhofer nor the A.D. [0003], whether taken alone or in allegedly obvious combination, teach or suggest at least the above noted distinguishing features of claims 1 and 11, and thus cannot be used to render the features of dependant claims 4-5 and 14-15 obvious under 35 U.S.C. § 103(a).

II. Conclusion

In light of the arguments above, as well as those set forth in Appellant's Brief on Appeal filed October 20, 2008. Appellant respectfully submits that the rejection of claims 1-19 under 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a) is improper and should be reversed.

Respectfully submitted,

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